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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	19281-000600US	8606
20350	7590	05/07/2004		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BROWN, RUEBEN M	
			ART UNIT 2611	PAPER NUMBER 10

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/687,151

Applicant(s)

SIE ET AL.

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-9.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 8-17 & 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle, (U.S. Pat # 5,530,754).

Considering claim 1, the claimed method for receiving a program by a user location that is sent from a content distributor, comprising receiving and storing a first portion of the program at the user location, reads on the disclosure in Garfinkle of receiving and storing a lead-in segment of a movie in the catalog store memory 22 at a user site 18; see Fig. 1; col. 1, lines 54-67 thru col. 2, lines 1-12; col. 3, lines 5-32; col. 4, lines 19-21 & col. 4, lines 48-50.

The claimed method of detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request is also met by the teachings of Garfinkle; col. 3, lines 25-31; col. 3, lines 60-67; col. 4, lines 1-16 & col. 5, lines 10-15.

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In particular, Garfinkle teaches that after a viewer watches previews of various movies, the instant viewer may choose product, i.e., movie, which is generally stored at a central site. This full-length product is then transmitted to the viewer, col. 3, lines 10-14; col. 3, lines 65-67 thru col. 4, lines 1-12 & col. 5, lines 3-9.

Considering claims 2, 11 & 16, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the catalog store 22, and begins to be displayed for the viewer; see Abstract; col. 1, lines 64-67 & col. 4, lines 12-25.

As for the limitation of claim 16 that the first portion is played before the second portion, Garfinkle teaches that the lead-in segment is played, and then the remaining segment of the movie is played; col. 4, lines 12-35 & col. 4, lines 66-67 thru col. 5, lines 1-3.

Considering claims 3, 12 & 17, the instant claims recite that a first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions. Accordingly, Garfinkle discloses that "the lead-in" which is stored at a user location memory 22 and played when a user selects its corresponding video product (i.e., movie), "is an initial segment of the video product sufficient in length to allow the downloading of the selected product to the user site", see col. 4, lines 19-35. Garfinkle goes on to further explain that, "For example, the lead-in segment may be of the order of two

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minutes long. In order to provide a seamless transition or splice from the catalog stored lead-in to the full video program stored material downloaded...”.

It is noted that the claims do not recite any restrictions regarding the length of the second portion itself, specifically as compared to the first portion. Therefore Garfinkle’s disclosure that the lead-in segment is of sufficient length to allow the downloading of the selected product reads on the claimed subject matter. For instance, Garfinkle discusses that if the user terminal does not have enough memory to store the entire movie, that the instant movie is transmitted in segments; col. 5, lines 14-22. The first transmission is only as much as the user terminal can store. When a certain number of minutes of the movie remain that have not been played from a particular segment, then the system transmits the next segment. Therefore the time needed to playback a downloaded portion of the movie is longer than the time for downloading the next portion of the movie.

Considering claims 5 & 13, the programs in Garfinkle that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 4, lines 12-67.

Considering claims 8 & 20, the claimed feature of determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first and second respective portion reads on the server in Garfinkle periodically transmitting the lead-in segments for any group of movies, col. 2, lines 1-12; col. 4, lines 45-58. It is disclosed that lead-ins are only generated for ‘certain products’, which reads on ‘determining a subset of

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programs'. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Garfinkle and col. 3, lines 5-17.

Considering claim 9, Garfinkle teaches that a certain of the movies at a central station 10, have lead-in segments, which reads on the claimed 'determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment'; see col. 2, lines 1-8.

The additional step of storing a second set of segments remotely from a user location reads on col. 4, lines 35-46, which discusses movies being housed in a product store 12 of the central station 10. The additionally claimed features of transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Garfinkle of downloading trailers or previews to the subscriber; col. 2, lines 1-6; col. 4, lines 9-12.

Considering claim 14, the claimed method of distributing content from a content distributor to a location, corresponds with subject matter mentioned above in the rejection of claim 1, and is likewise treated. The instant claim additionally recites transmitting a first portion

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of the program to the location, which reads on col. 3, lines 1-17 & col. 4, lines 46-50. As for waiting for a user request, the claimed subject matter is inherently included in Garfinkle, since the main video program is not transmitted until after the user requests the instant movie; col. 5, lines 3-5.

Considering claim 15, the claimed step of transmitting a plurality of portions in response to detecting the user request, such that the second portion is one of the plurality of portions, also reads on the disclosure of Garfinkle. Garfinkle discloses that depending upon how much storage is available at the user's site 18; the entire movie may or may not be transmitted as a single unit (col. 5, lines 14-22). In other words, if the user's site cannot store the entire movie, then the movie is delivered in multiple transmissions, i.e. portions or segments.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 4, 6-7 & 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle.

Considering claim 6, even though the user site 18 of Garfinkle includes numerous functions of a set-top box, the reference does not explicitly disclose a set-top box. Official Notice is taken that at the time the invention was made, it was well known in the art to use a set-top box in a video-on-demand system. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the feature of a set-top box, at least for the well known benefits of a set-top box, such as increased flexibility and processing power.

Considering claim 7, Garfinkle generally discusses a storage medium used to house the catalog store memory 22; col. 3, lines 5-30, but does not explicitly state the use of a mass storage device. Official Notice is taken that at the time the invention was made, that using a mass storage device, such as a laserdisc or DVD in conjunction with a set-top box for VOD was well-known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the feature of mass storage device, such as laserdisc or DVD, at least for the desirable advantages of high amount of memory available on physically small device, which are smaller than VHS tapes, for instance.

Considering claims 4 & 18, Garfinkle discusses the use of a TV remote control or mouse, without explicitly disclosing a wireless feature; see col. 3, lines 50-54 & Fig. 3. Official Notice is

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taken that at the time the invention was made, wireless TV remote control was old in the art, using either RF or infrared technology. It would have been obvious for one of ordinary skill in the art at the time the invention was made to operate Garfinkle with a wireless remote control, for the desirable benefit of improving upon the use of hard wired input devices, generally providing the user with a wider range of distance for inputting commands and obviates the cumbersome nature of wires. As for the claimed processing the request to determine a desired program; the instant subject matter is met by col. 3, lines 62-67.

Considering claim 19, Garfinkle teaches that both the first and second segments are transmitted to the user, but does not state that the segments are transmitted on the same channel. Official Notice is taken that at the time the invention was made, it was known to transmit multiple portions of movies over a common channel. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Garfinkle, to transmit multiple portions of a movie over the same channel, at least for the desirable benefit of avoiding the subscriber having to change channels, in order to receive subsequent portions of the movie.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's claims.

- A) Inoue Teaches downloading a first segment of a movie to a receiver, which is equal to the time of transmitting the remainder of the movie (Abstract; col. 3, lines 55-64).
- B) Dunn Teaches storing previews of movies on a subscriber's set-top box.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
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**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 746-6861 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.

The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9306 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

REUBEN M. BROWN  
PATENT EXAMINER  
*Reuben M. Brown*